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09/827,029	04/05/2001	James M. Barton	TIVO0003C	9852

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EXAMINER

TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2615

9

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,029

Applicant(s)

BARTON ET AL.

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on Sept. 05, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,233,389 B1 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

2. Applicant's arguments filed Sept. 05, 2003 have been fully considered but they are not persuasive.

In re pages 5-6, applicants argue, with respect to the rejection of claims 19-28, 30-39, 41-50, 52-62, and 64 under 35 U.S.C. §103(a), that Ito does not teach or disclose what the Office Action states because the Office Action states "Ito et al teaches a video and/or audio data recording and/or reproducing apparatus having editing apparatuses 90 for editing audio and/or video signal stored in the server system 8 (col. 2, lines 45-58) so that the appropriate video signal can be broadcast (col. 1, lines 15-25)" and Ito does not teach the above. Ito's editing apparatuses 90 are external editors that access the server system 8 to edit material on the server system. Ito clearly shows that the system is a client-server apparatus where a user interfaces with the server system a through external editing apparatuses 90 shown in Fig. 2. Col. 2, lines 44-68 state (emphasis added):

"FIG. 2 is a view of the configuration of an editing system 9 using the server system 8 shown in FIG. 1.

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When audio and/or video data are edited by using the server system 8, as shown in for example FIG. 2, use is made of an editing system 9 comprised of editing apparatuses 90.sub.1 and 90.sub.2, connected to a server system 8, each of which having two audio and/or video data input terminals and one audio and/or video output terminal (AV) and a control signal terminal (C) corresponding to each of these audio and/or video signal input/output terminals and performing cutting to connect a plurality of audio and/or video data or addition of special effects to the audio and/or video data. The editor edits the audio and/or video data supplied from the server system 8 by using the editing apparatuses 901 and 902 and records the result in the server system 8 again."

In response, the examiner respectfully disagrees. As recognized by applicants, the editing system 9 of Ito et al is used for editing the video and/or audio signal recorded on the server system 8 to generate desirable video signal. Ito et al also teaches that the server system 8 is used in the television broadcasting station (col. 2, lines 59-67). Thus, Ito et al does indeed teach the capability of broadcasting appropriate video signal because the television broadcasting station of Ito et al would broadcast the appropriate video signal edited by the editing system 9.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 19-28 and 30-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (Re. 36,801) in view of Ito et al ('894 B2).

Regarding claim 19, Logan et al discloses a process of the simultaneous storage and playback of multimedia data in a computer environment (Fig. 1), comprising the steps of:

providing a plurality of input signal tuners (input signal processing units 12 of Fig. 1, col. 3, lines 4-17 and lines 47-62);

wherein said tuners accept analog and digital television broadcast signals (col. 3, lines 47-62);

wherein each of said tuners is individually tuned to a specific broadcast signal (col. 3, lines 47-62 and col. 4, lines 30-45);

converting analog television broadcast signals into a digital signal (col. 4, lines 6-29);

storing said digital signals and digital television broadcast signals on a storage device (memory subsystem 5 of Fig. 1, col. 3, lines 4-26);

providing an output device (video display unit 10 of Fig. 1, col. 3, lines 4-26);

wherein said output device extracts a specific digital signal from said storage device (col. 3, line 63 to col. 4, line 5);

decoding said specific digital signals into a television output signal (col. 4, lines 6-29);

sending said television output signal to a television monitor (video display unit 10 of Fig. 1, col. 3, lines 4-26); and

wherein said plurality of output devices allows for a picture in a picture display on said television monitor (picture-in-picture disclosed in col. 5, lines 38-50). However, Logan et al does not specifically disclose a plurality of output devices.

to et al teaches a video and/or audio data recording and/or reproduction apparatus having editing apparatuses 90 for editing audio and/or video signal stored in the server system 8 (col. 2, lines 45-58) so that the appropriate video signal can be broadcast (col. 1, lines 15-25).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the editing apparatus 90 as taught by Ito et al into Logan et al's system in order to achieve the desirable video signal to be broadcasted.

Regarding claim 20, Logan et al also discloses the claimed step of accepting control commands from a user (col. 3, line 63 to col. 4, line 5).

Regarding claim 21, Logan et al discloses the claimed wherein the user selects the picture in a picture option to be displayed on said television monitor (picture-in-picture disclosed in col. 5, lines 38-50).

Regarding claim 22, Logan et al discloses the claimed wherein the user selects which of said output devices displays in said picture in a picture display (picture-in-picture disclosed in col. 5, lines 38-50).

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Regarding claim 23, Logan et al discloses the claimed wherein the user selects the display position of each picture in the picture in a picture display (picture-in-picture disclosed in col. 5, lines 38-50).

Regarding claim 24, Logan et al discloses the claimed wherein the user selects an individual tuner and the specific broadcast signal for said individual tuner (4A-4D of Fig. 1, col. 3, lines 47-62).

Regarding claim 25, Logan et al discloses the claimed wherein the user selects a specific video and audio component to be extracted from said storage device and decoded (col. 3, line 63 to col. 4, line 5).

Regarding claim 26, Logan et al discloses the claimed wherein the user controls the decoding rate and direction of said decoding step to perform variable rate fast forward and rewind, frame step, pause, and play functions on said television output signal (col. 3, line 63 to col. 4, line 29).

Regarding claim 27, Logan et al discloses the claimed the step of inserting on screen displays into said television output signal (picture-in-picture disclosed in col. 5, lines 38-50).

Regarding claim 28, Logan et al teaches the claimed wherein the specific broadcast signal for an individual tuner is selected automatically based on the current date and time (col. 3, lines 39-46).

The corresponding apparatus claims 30-39 are rejected for the same reasons as discussed in method claims 19-28 above.

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5. Claims 29 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (Re. 36,801) in view of Ito et al ('894 B2) as applied to claims 19 and 30 above, and further in view of Yuen et al ('409).

Regarding claim 29, the combination of Logan et al and Ito et al discloses all the claimed limitations as discussed in claim 19 above except for providing wherein the specific broadcast signal for an individual tuner is selected automatically based on a particular word or phrase in said broadcast signal.

Yuen et al teaches an apparatus and method for tracking the playing of VCR programs including means for automatically selecting the broadcast signal for tuner based on particular word or phrase in said broadcast signal (program guide disclosed col. 31, lines 29-41).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of selecting video program based on program guide as taught by Yuen et al into Logan et al's system in order to increase the flexibility of Logan et al by programming the video recorder using the program guide for recording shows during his absence or sleep.

The corresponding apparatus claim 40 is rejected for the same reasons as discussed in method claim 29 above.

6. Claims 41-50, 52-62, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (Re. 36,801) in view of Ito et al ('894 B2) and further in view of Hirayama et al ('356).

Regarding claim 41, the combination of Logan et al and Ito et al as discussed in claim 19 above discloses all the claimed limitations except for providing separating a digital signal or digital television broadcast signal into its video and audio components and storing said video and audio components on a storage device.

Hirayama et al teaches an apparatus and processing compressed video signals having means for separating digital signal into its video and audio components (col. 8, lines 36-67) and means for storing said video and audio components on a storage device (col. 8, lines 36-67) for easily managing data, which can reproduce programs in a special manner and search them at high speed, and synchronize a video signal and an audio signal by using simple means (col. 1, lines 48-54).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capabilities of processing and recording/reproducing video, audio, and subtitle separately as taught by Hirayama et al into Logan et al's system in order to simplify the managing of the data, which can reproduce programs in a special manner and search time at high speed, and to synchronize video and audio signal using simple means.

Regarding claim 42, Logan et al also discloses the claimed step of accepting control commands from a user (col. 3, line 63 to col. 4, line 5).

Regarding claim 43, Logan et al discloses the claimed wherein the user selects the picture in a picture option to be displayed on said television monitor (picture-in-picture disclosed in col. 5, lines 38-50).

Regarding claim 44, Logan et al discloses the claimed wherein the user selects which of said output devices displays in said picture in a picture display (picture-in-picture disclosed in col. 5, lines 38-50).

Regarding claim 45, Logan et al discloses the claimed wherein the user selects the display position of each picture in the picture in a picture display (picture-in-picture disclosed in col. 5, lines 38-50).

Regarding claim 46, Logan et al discloses the claimed wherein the user selects an individual tuner and the specific broadcast signal for said individual tuner (4A-4D of Fig. 1, col. 3, lines 47-62).

Regarding claim 47, Logan et al discloses the claimed wherein the user selects a specific video and audio component to be extracted from said storage device and decoded (col. 3, line 63 to col. 4, line 5).

Regarding claim 48, Logan et al discloses the claimed wherein the user controls the decoding rate and direction of said decoding step to perform variable rate fast forward and rewind, frame step, pause, and play functions on said television output signal (col. 3, line 63 to col. 4, line 29).

Regarding claim 49, Logan et al discloses the claimed the step of inserting on screen displays into said television output signal (picture-in-picture disclosed in col. 5, lines 38-50).

Regarding claim 50, Logan et al teaches the claimed wherein the specific broadcast signal for an individual tuner is selected automatically based on the current date and time (col. 3, lines 39-46).

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Regarding claim 52, Hirayama et al teaches the claimed extracting other signal components from said digital signal or said digital television broadcast signal (subtitle data disclosed in col. 8, lines 36-67); wherein said storage step stores said other signal components on said storage device (col. 8, lines 36-67); wherein said output device extracts the associated signal components of said specific video and audio components from said storage device (col. 9, lines 6-24); and reproducing said associated signal components into their proper location in said television output signal (col. 9, lines 6-24).

The corresponding apparatus claims 53-62 and 64 are rejected for the same reasons as discussed in method claims 19-28 and 52 above, respectively.

7. Claims 51 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (Re. 36,801) in view of Ito et al ('894 B2) and Hirayama et al ('356) as applied to claims 41 and 53 above, and further in view of Yuen et al ('409).

Regarding claim 51, the combination of Logan et al, Hirayama et al, and Ito et al discloses all the claimed limitations as discussed in claim 41 above except for providing wherein the specific broadcast signal for an individual tuner is selected automatically based on a particular word or phrase in said broadcast signal.

Yuen et al teaches an apparatus and method for tracking the playing of VCR programs including means for automatically selecting the broadcast signal for tuner based on particular word or phrase in said broadcast signal (program guide disclosed col. 31, lines 29-41).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of selecting video program based on program

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guide as taught by Yuen et al into Logan et al's system in order to increase the flexibility of Logan et al by programming the video recorder using the program guide for recording shows during his absence or sleep.

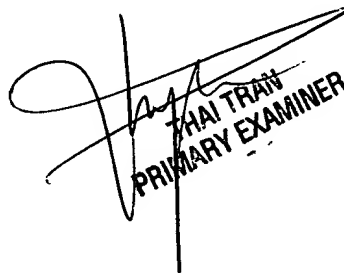
The corresponding apparatus claim 63 is rejected for the same reasons as discussed in method claim 51 above.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

TTQ


THAI TRAN
PRIMARY EXAMINER